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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/704,425	11/01/2000	Kevin J. Nicholls	WA23-040	4626

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EXAMINER

COSIMANO, EDWARD R

ART UNIT	PAPER NUMBER
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3629

DATE MAILED: 11/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/704,425

Applicant(s)

NICHOLLS ET AL.

Examiner

Edward R. Cosimano

Art Unit

3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) none is/are withdrawn from consideration.
- 5) ☒ Claim(s) 14-20 is/are allowed.
- 6) ☒ Claim(s) 1-13, 21-24 and 26-34 is/are rejected.
- 7) ☒ Claim(s) 25 and 26 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11/1/00 & 6/30/04 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Art Unit: 3629

1. Applicant should note the changes to patent practice and procedure:
 - A) effective December 01, 1997 as published in the Federal Register, Vol 62, No. 197, Friday October 10, 1997;
 - B) effective November 07, 2000 as published in the Federal Register, Vol 65, No. 54603, September 08, 2000; and
 - C) Amendment in revised format, Vol. 1267 of the Official Gazette published February 25, 2003.
 2. The proposed drawing correction and substitute sheets filed June 30, 2004 have been approved.
 3. The use of various trademark(s), for example: "Zip™";
 - A) in the paragraph between page 8, line 4, and page 9, line 11, "With reference to the various systems ... Zip™ drive ... computer system making up the host computer."
- has been noted in this application. Any trademarks should be capitalized wherever they appear and be accompanied by the generic terminology.
- 3.1 Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.
4. The disclosure is objected to because of the following informalities:
 - A) the subject matter of:
 - (1) claim 13 in regard to the recited "telecommunications; transportation; manufacturing, leases and manufacturing and repair services";
- lacks antecedent basis within the specification as required by 37 CFR § 1.75(d1).
- Appropriate correction is required.
5. The specification and drawings have not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification or drawings. Applicant should note the requirements of 37 CFR § 1.74, § 1.75, § 1.84(o,p(5)), § 1.121(a)-1.121(f) & § 1.121(h)-1.121(i).

Art Unit: 3629

6. Claims 1-13, 21-24 & 26-34 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

6.1 Claims 1-13, 21-24 & 26-34 are inoperative and therefore lack utility for the recited purpose of the disclosed and claimed invention, since:

A) in regard to claims 1-13, 21-24 & 26-34, the preambles of claims 1, 21, 27 & 33 recite a "computerized method for providing cost savings for utility users", however, as can be seen in each of these claims, the language of the claims never actually requires the user/customer implement, that is use, the selected utility rate in order to achieve any cost savings. Hence, the user/customer does not achieve any of the cost savings that are implied in the preamble of these claims as the utility of the claimed invention.

For as the Court has specifically pointed out, claims must recite utility for the disclosed purpose of the invention, (General Electric Co. V. U.S., 198 U.S.P.Q. 65 (U.S. Court of Claims, 1978), Hanson v. Alpine Valley Ski Area 204 U.S.P.Q. 794 (District Court, E. D. Michigan, N. Div. 1978) and Banning v. Southwestern Bell Telephone C., 182 U.S.P.Q. 683 (SD Tex, 1974)).

6.2 The subject matter of:

A) claim 13 in regard to the recited "telecommunications; transportation; manufacturing, leases and manufacturing and repair services";

lacks antecedent basis within the specification as required by 37 CFR § 1.75(d1).

6.3 Claims not specifically mentioned above, inherit the defects of the base claim through dependency. For the above reason(s), applicant has failed to particularly point out what is regarded as the invention.

7. The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject

matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

(c) Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

7.1 Claims 1 & 2 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the Arkansas Business article, herein after (AB) or Callen (6,556,976) in view of obvious business concerns.

7.1.1 In regard to claims 1 & 2, either AB or Callen ('976) discloses a third party that access:

A) a first data base of historical consumption/billing information for the various goods/services that are consumed/used by the user; and

B) a second data base of costing/pricing/rating information for the goods/services from various suppliers/vendors/merchants, that is, a second party, for the goods/services that are supplied to the user.

The third party then analyses the first data base in view of the second data base in order to determine the optimum/best supplier of the goods/services consumed by the user. Once the optimum supplier of the goods/services consumed by the user has been determined, the user is notified of the identified optimum supplier of the goods/services consumed by the user. From this information the user may act appropriately in order to benefit from the third party's analysis.

7.1.2 In regard to the viewing of the results of the analysis by the user, it is noted that without the user/customer being able to review and act upon the results of the third party's analysis, the user could not benefit from the potential cost savings that may have been indicated by the third party's analysis, therefore, it would have been obvious to one of ordinary skill at the time the invention was made that the systems of either AB or Callen ('976) could be modified to provide to the user/customer or an authorized agent of the user/customer the

Art Unit: 3629

ability to view and act upon the results of the third party's analysis by the use any suitable method of communication link.

7.1.3 In regard to the cost allocation of the savings of the user, since it is noted that a business that does not generate revenue and pay it's bill would not stay in business very long, it would have been obvious to one of ordinary skill a the time the invention was made that the systems of either AB or Callen ('976) could be modified to bill the user for the services that have been provided to the user and then use the acquired fees to pay it's bills, for example for receiving the data from the various data bases and for services that the third party has used.

8. 35 U.S.C. § 101 reads as follows:

"Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title".

8.1 Claims 1-13, 21-24 & 26-34 are rejected under 35 U.S.C. § 101 because the invention as claimed is directed to non-statutory subject matter, since it fails to comply with the "requirements this title, namely 35 U.S.C. § 112 2nd paragraph and/or 35 U.S.C. § 103 as set forth above.

8.2 Claims 1-13, 21-24 & 26-34 are rejected under 35 U.S.C. § 101 because the invention as claimed is directed to non-statutory subject matter, since they lack substantial and practical utility.

A) it is respectfully noted that claims 1-13, 21-24 & 26-34 lack utility for providing any cost savings for utility users as stated in the preambles of these claims 1, 21, 27 & 33, since as can be seen in each of these claims, the language of the claims never actually requires the user/customer implement, that is use, the selected utility rate in order to achieve any cost savings. Hence, the user/customer would not achieve any of the cost savings that are implied in the preamble of these claims as the utility of the claimed invention.

In view of the above, it is considered that the invention of claims 1-13, 21-24 & 26-34 lack substantial and practical utility.

Art Unit: 3629

9. The following is an Examiner's Statement of Reasons for Allowance over the prior art of record:

A) in regard to claims 3 & 23, the prior art does not teach or suggest processing historical billing data for a customer in order to determine tolerance parameters for the consumption information of the customer and then using an audit of the customer's consumption data to determine if the consumption data meets the determined tolerances. Claims 4-13 are allowable over the prior art for the same reason.

B) in regard to claim 9, the prior art does not teach or suggest processing only utility rate information that meets the cost saving tolerance parameter for the consumption history information of the customer. Claims 10-13 are allowable over the prior art for the same reason.

C) in regard to claim 10, the prior art does not teach or suggest permitting the user to act on the processed information/data and then using any determined cost savings by the customer as a shared fee among the first and second parties. Claims 11-13 are allowable over the prior art for the same reason.

D) in regard to claim 14, the prior art does not teach or suggest processing historical consumption history data against predetermined tolerance values and then using the results of the processing to permit the user/customer to subscribe to a rate schedule that would provide some amount of cost saving to the user/customer, while compensating the first and second parties based on the cost savings of the user/customer. Claims 15-20 are allowable for the same reason.

E) in regard to claims 21, 27 & 33, the prior art does not teach or suggest processing historical consumption history data against predetermined tolerance values and then using the results of the processing to permit the user/customer to select a rate schedule that would provide some amount of cost saving to the user/customer, while compensating the first and second parties based on the cost savings of the user/customer. Claims 22-26, 28-32, 34 & 35 are allowable for the same reason.

10.

Response to applicant's arguments.

Art Unit: 3629

10.1 All rejections and objections of the previous Office action not repeated or modified and repeated here in have been over come by applicant's last response.

10.2 As per the objections to the drawings and disclosure, since applicant failed to address or correct these problems, they have been repeated.

11. Claim 3-13, 25 & 35 would be allowable if rewritten to overcome the rejection under 35 U.S.C. § 112 and to include all of the limitations of the base claim and any intervening claims. As allowable subject matter has been indicated, applicant's response must either comply with all formal requirements or specifically traverse each requirement not complied with. See 37 C.F.R. § 1.111(b) and section 707.07(a) of the M.P.E.P.

12. The shorten statutory period of response is set to expire 3 (three) months from the mailing date of this Office action.


13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edward Cosimano whose telephone number is (703) 305-9783. The examiner can normally be reached Monday through Thursday from 7:30am to 6:00pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss, can be reached on (703)-308-2702. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113.

13.1 The fax phone number for UNOFFICIAL/DRAFT FAXES is (703) 746-7240.

13.2 The fax phone number for OFFICIAL FAXES is (703) 872-9306.

13.3 The fax phone number for AFTER FINAL FAXES is (703) 872-9306.

10/30/04


Edward R. Cosimano
Primary Examiner A.U. 3629